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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,058	11/13/2001	Tadashi Kondo	Q67226	6301

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EXAMINER

HUBER, PAUL W

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,058

Applicant(s)

KONDO, TADASHI

Examiner

Paul Huber

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9 and 12-15 is/are rejected.
- 7) ☒ Claim(s) 5, 10 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 recites the limitation "the necessary area" in line 2. There is insufficient antecedent basis for this limitation in the claim. Perhaps, the applicant meant for claim 12 to actually depend from claim 7 (see dependency of similar claim 11).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-9, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato (USP-5,937,136).

Regarding claims 1, 3, 4, 6, 8, 9, 13 and 14, Sato discloses an information recording/reproducing apparatus for recording information on a recording medium and for reproducing recorded information from the recording medium in accordance with a reproducing procedure designated by a user. See abstract and figure 9. The "...description [in reference to figures 13-15] is related to an example of the video data edit/reproduction apparatus which can rearrange the contents of the recording medium by programming so that scenes not selected by the operator are regarded as 'unnecessary' and only necessary scenes are left in a reproduction program" (col. 11, lines 39-44). "If needed, the recording medium may be initialized by clearing to zero or null in order to logically erase data in areas in which unnecessary scenes are stored" (col. 12, lines 24-26). Therefore, the information recording/reproducing apparatus, comprises: a detecting unit for detecting an unnecessary portion of the recorded information which is not to be reproduced according to any one of the reproducing procedure as claimed; and an erasing unit for erasing the recorded information corresponding to the unnecessary portion as claimed.

Regarding claims 2 and 7, the detecting unit comprises: a first unit for detecting necessary portion of the recorded information which is to be reproduced by the reproducing procedure for all of the reproducing procedure (see figure 15, steps S52-S59); and a second unit for determining the portion of the recorded information other than the necessary portion detecting by the first unit as the unnecessary portion (see col. 12, lines 24-26).

Claims 6 and 12-15, as clear and understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Haneda (USP-6,094,693).

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Regarding claims 13 & 15, Haneda discloses an apparatus in reference to figures 8, 13 & 14 comprising: a pickup (see col. 9, lines 51-54, for recording medium 3 being a "disc medium"); a control circuit 2, wherein the control circuit detects unnecessary data (vacant area) recorded on a recording medium (see steps S103-S104), and wherein the control circuit 2 controls the pickup to erase the unnecessary data (see steps S204-S207).

Regarding claim 14, the "file erased for securing the vacant area may be ...a file selectively designated by the user using the function selection section 7" (col. 16, lines 27-30). Thus, the unnecessary data is selected by a user as being unnecessary.

Regarding claims 6 & 12, as clear and understood, Haneda discloses a computer readable information recording medium 3 storing a control program (file management information) readable by a computer apparatus and making the computer apparatus to function as an information recording/reproducing apparatus for recording information on a recording medium and for reproducing recorded information from the recording medium in accordance with a reproducing procedure designated by a user, comprising: a detecting unit for detecting an unnecessary area (vacant area) on the recording medium 3 where an unnecessary portion of the recorded information which is not to be reproduced according to the reproducing procedure is recorded (see steps S103-S104); and an erasing unit for erasing the unnecessary area (see steps S204-S207). The erasing unit leaves positions of a necessary area and a second non-contiguous necessary area on the recording medium unchanged.

Claims 5, 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Note: claim 12 would be allowable if amended to depend from claim 7 and if then rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed October 12, 2004 have been fully considered but they are not persuasive. The applicant argues that since "Sato teaches detecting necessary scenes and rewriting the necessary scenes so that they are contiguous, ... Sato does not disclose, teach or otherwise suggest detecting unnecessary areas and erasing unnecessary areas, as recited by claim 1." The examiner respectfully disagrees. Sato teaches detecting unnecessary areas located between necessary areas 1, 2, 4, etc. (see figures 13 & 14), by detecting the necessary areas' start and end positions. For example, the end position of necessary area 1 and the start position of necessary area 2 is the start position and end position, respectively, of an unnecessary area located between the necessary area 1 and the necessary area 2. In this way of detecting all necessary areas located on the recording medium, the user has detected the unnecessary areas located on the recording medium as well. Furthermore, Sato recites that

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"the recording medium may be initialized by clearing to zero or null in order to logically erase data in areas in which unnecessary scenes are stored" (col. 12, lines 24-26) as further evidence that Sato detects and erases unnecessary areas as claimed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Paul Huber at telephone number 571-272-7588.



Paul Huber
Primary Examiner
Art Unit 2653

pwh
April 4, 2005